

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ALEXANDER THOEMMES  
and BRETT K. BLOOMQUIST

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Application 09/256,896

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on May 24, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On March 23, 2004 (Paper No. 13), the examiner mailed a Response to the Reply Brief. This response is improper, in that it contains a rebuttal of the Reply Brief, which is considered a Supplemental Examiner's Answer. 37 CFR § 1.193(b)(1) clearly states:

The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the Reply Brief. A supplemental examiner's answer IS NOT PERMITTED, UNLESS REMANDED by the Board of Patent Appeals and Interferences for such purpose. (Emphasis added)

Since there was no remand for the Supplemental Examiner's Answer mailed March 23, 2004, the paper is improper. The examiner has two options to correct this error: 1) to vacate the paper mailed March 23, 2004, and make a proper response to the Reply Brief or 2) vacate the paper filed March 23, 2004 and reopen prosecution in accordance with 37 CFR § 1.193 (b)(1).

On May 27, 2004, applicants filed a timely Supplemental Reply Brief (Paper No. 14).

In accordance with the revision effective December 1, 1997, Title 37, Code of Federal Regulations, §1.193 states:

(b)(1)... The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief.

In view of this revision, the examiner must either: 1) reopen prosecution in order to respond to the Supplemental Reply Brief (Paper No. 14), or 2) acknowledge receipt and entry of the Supplemental Reply Brief.

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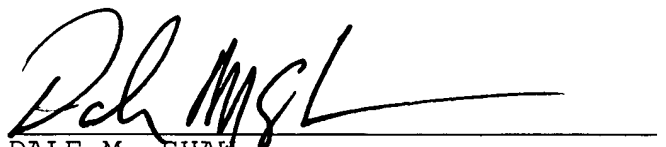
Accordingly, it is

**ORDERED** that the application is returned to the  
Examiner to:

- 1) vacate the Response to the Reply Brief mailed March 14, 2004 (Paper No. 13);
- 2) either reopen prosecution or mail a proper response to the Reply Brief filed Dec. 22, 2003 (Paper No. 12);
- 3) notify the applicant, in writing, of which option the examiner has chosen above;
- 4) properly consider the supplemental Reply Brief filed May 27, 2004 (Paper No. 14); and
- 5) for such further action as appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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RA04-0604

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